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Remarks:

Amendments to the claims:

Claims 1-16 are pending in this application, with claims 2, 3, 8-10 and 16 withdrawn from consideration. By this Amendment, claims 7, 9 and 10 are amended.

No new matter is added to the application by this Amendment. The language added to claim 7 finds support in claim 2 as originally filed. The language added to claims 9 and 10 finds support in the specification, as originally filed, at, for example, page 5, lines 9-24 and page 6, lines 8-19.

Regarding rejoinder of the withdrawn claims and the withdraw of claim 7 as allegedly being dependent upon elected claim 4 and non-elected claim 2:

Claim 7 has been amended such that the claim is not dependent from non-elected claim 2, and only depends upon elected claim 4. Accordingly, claim 7 is directed to a mixture comprising a compound of the elected species and an additional compound, namely a compound of a non-elected species.

Applicant submits that claim 7 should not be withdrawn and should remain in the instant set of claims because the claims include the elected species as a linking feature. Thus, Applicant respectfully requests that claim 7 be rejoined and considered on the merits at this time.

Applicant further respectfully submits that, because claims 1, 4-6 and 9-16 are in condition for allowance for the reasons set forth below, claims 2, 3, 7 and 8 should be rejoined and considered on the merits at this time. Thus, withdrawal of the Restriction Requirement and rejoinder of claims 2, 3, 7 and 8 are respectfully requested.

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Regarding the rejection of claims 9 and 10 under 35 USC 112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention:

The Patent Office rejected claims 9 and 10 under 35 USC 112, second paragraph, as allegedly being indefinite because the claims use the term "use" in the preamble and lack a definite method step. As a result, the Patent Office also withdrew claims 9 and 10 from consideration.

Claims 9 and 10 are amended to be directed to a fragrance application comprising the compound of claim 1. Amended claims 9 and 10 do not use the term "use" in their preambles and do not require a definite method step as alleged by the Patent Office.

Applicant submits that claims 9 and 10 should not be withdrawn and should remain in the instant set of claims. Thus, Applicant respectfully requests that claims 9 and 10 be rejoined and considered on the merits at this time.

Regarding the rejection of claims 1 and 6 under 35 USC 102(b) as allegedly being anticipated by Chemical Abstract AN. #1995:818045 CAPLUS (1995 CAPLUS), Chemical Abstract AN. #2000:184161 CAPLUS (2000 CAPLUS), or Chemical Abstract AN. # 1984:610054 CAPLUS (1984 CAPLUS):

The Applicant respectfully traverses the rejection of the foregoing claims in view of 1995 CAPLUS, 2000 CAPLUS and 1984 CAPLUS.

Prior to discussing the relative merits of the Patent Office's rejection, Applicant points out that unpatentability based on "anticipation" type rejection under 35 USC 102(b) requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented

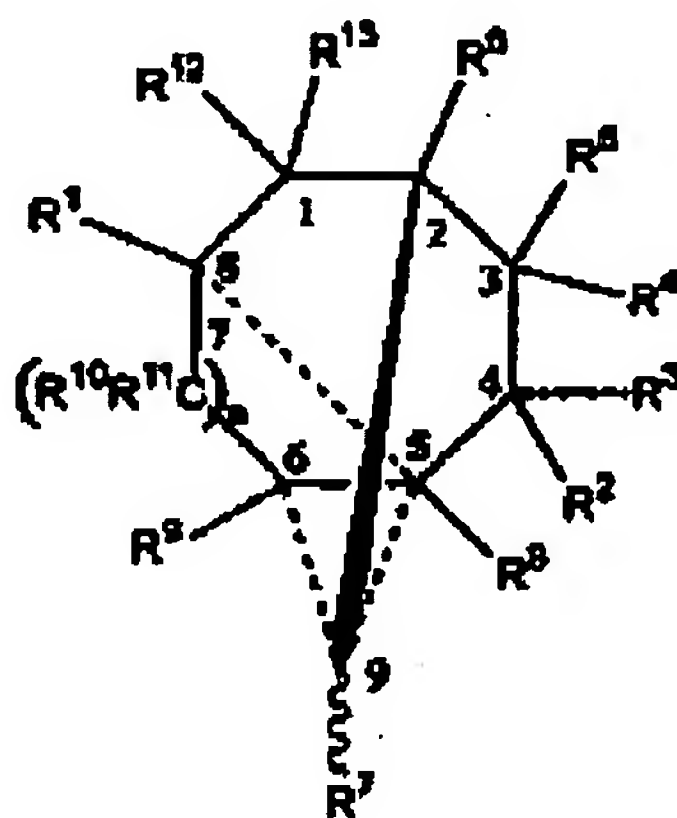
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by the patentee"). Anticipation requires that a *single reference* [emphasis added] describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The Patent Office alleges that (a) 1995 CAPLUS discloses a compound of tricycle [3.2.1]octan-2-one, 1,8,8-trimethyl, (b) 2000 CAPLUS discloses a compound of tricycle [3.2.1]octan-6-one, 3,3,5-trimethyl, and (c) 1984 CAPLUS discloses a compound of tricycle [3.2.1]octan-2-one, 1,8,8-trimethyl.

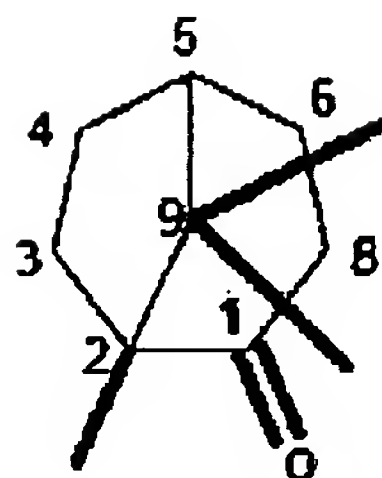
1995 CAPLUS and 1984 CAPLUS disclose the same compound, namely, tricycle [3.2.1]octan-2-one, 1,8,8-trimethyl. None of 1995 CAPLUS, 2000 CAPLUS and 1984 CAPLUS, taken singly or in combination, teaches or suggests a compound that even falls under claimed formula I:



The compound disclosed in 1995 CAPLUS and 1984 CAPLUS is:

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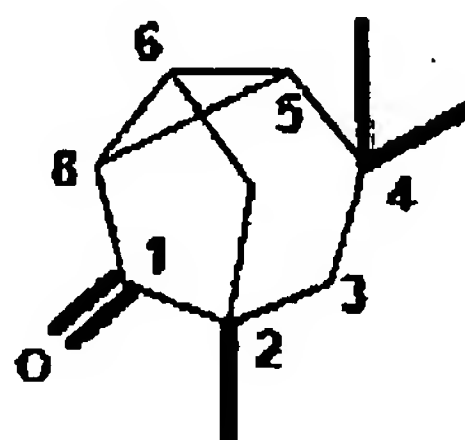
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CAS 2942-87-2

The compound of 1995 CAPLUS and 1984 CAPLUS is not covered by the claimed formula I because the compound of formula I has none or only one substituent at C9. The compound taught in 1995 CAPLUS and 1984 CAPLUS clearly has two substituents at C9.

The compound disclosed in 2000 CAPLUS is:



CAS 266676-96-4

2000 CAPLUS fails to teach or suggest a compound having a branched lower $C_3 - C_7$ alkyl ($=R^9$) substituted at C6 and C9 and C5 not to be connected (see option b of claim 1) when C5 and C8 are connected by a single bond and C9 and C6 are connected by a single bond as recited in claim 1.

The principle of "inherency," in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject

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matter of the reference, when viewed by persons experienced in the field of the invention. However, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

Thus when a claim limitation is not explicitly set forth in a reference, evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co.*, 948 F.2d at 1268. It is not sufficient if a material element or limitation is "merely probably or possibly present" in the prior art. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002). See also, *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references"); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

It is believed that the Patent Office has not properly made its case that the currently claimed invention is properly rejected as being anticipated under 35 USC 102(b) by 1995 CAPLUS, 2000 CAPLUS and 1984 CAPLUS, taken singly or in combination. Accordingly, reconsideration of the propriety of this rejection and its withdrawal is solicited.

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Regarding the rejection of claims 4, 5 and 12-16 under 35 USC 103(a) as allegedly being unpatentable over 1995 CAPLUS, 2000 CAPLUS, and 1984 CAPLUS:

The Applicant respectfully traverses the rejection of the foregoing claims in view of 1995 CAPLUS, 2000 CAPLUS, and 1984 CAPLUS.

Prior to discussing the merits of the Examiner's position, the undersigned reminds the Examiner that the determination of obviousness under § 103(a) requires consideration of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 [148 USPQ 459] (1966): (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. *McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1368, 67 USPQ2d 1649, 1653 (Fed. Cir. 2003). See also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2D 1385 (U.S. 2007).

A methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the

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applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

On page 3 of the Office Action, the Patent Office acknowledges that 1995 CAPLUS, 2000 CAPLUS, and 1984 CAPLUS differ from Applicant's invention in the following ways: (1) they fail to teach a compound that falls within Applicant's claimed compounds of claims 4 and 5, (2) it is unclear the exact synthesis processes used to make the compounds as required in claims 15 and 16, and (3) there is not a direct disclosure to the use of the compounds to make flavor or fragrance compositions as set forth in claims 12-14.

The Patent Office alleges that (1) it would have been obvious to one having ordinary skill in the art to use the disclosures of the references from which the Chemical Abstracts were taken as additional motivation to make compounds that fall within Applicant's claimed compounds, and to make these compounds by a method that reads on Applicant's claimed method, (2) the use of ketones in flavor or fragrance compositions is deemed to be at once envisaged since these types of ketones are well known in the art to be highly aromatic, and (3) ketones in general are well known fragrances.

Applicant submits that the compounds disclosed in 1995 CAPLUS, 2000 CAPLUS, and 1984 CAPLUS have nothing in common with the compounds of general formula I (claims 1 and 15) and general formula Ic (claim 16). Contrary to the allegations of the Patent Office, as set forth above with respect to the rejection of claim 1 under 35 USC 102, none of the compounds disclosed in 1995 CAPLUS, 2000 CAPLUS, and 1984 CAPLUS even fall within the requirement of formula I as specifically defined in independent claim 1 (from which claims 4, 5 and 12-14 depend) and independent claim 15. Moreover, 1995 CAPLUS, 2000 CAPLUS, and 1984 CAPLUS, taken singly or in combination fail to teach or suggest a compound of general formula Ic as recited in claim 16.

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Because these features of independent claims 1, 15 and 16 are not taught or suggested by 1995 CAPLUS, 2000 CAPLUS, and 1984 CAPLUS, these references would not have rendered the features of claim 4, 5 and 12-16 obvious to one of ordinary skill in the art.

In view of the foregoing, reconsideration and withdrawal of this rejection are respectfully requested.

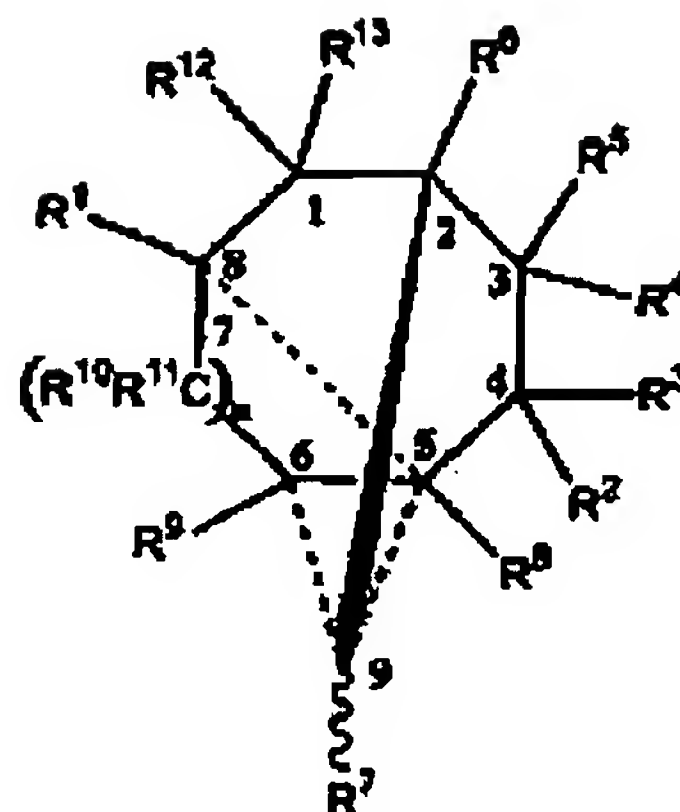
Regarding the rejection of claims 1, 4-6, 15 and 16 under 35 USC 102(b) as allegedly anticipated by or, in the alternative, under 35 USC 103(a) as allegedly being unpatentable over Applicant cited Article XP-002254318 entitled: Regiochemical Trends in Intramolecular [2 +2] Photocycloadditions of 6-(Prop-2-enyl)cyclohex-2-enones and 5-(prop-2-enyl)cyclopent-2-enones by Giuliano Cruciani et al. (Cruciani et al.):

The Applicant respectfully traverses the rejection of the foregoing claims in view of Cruciani et al.

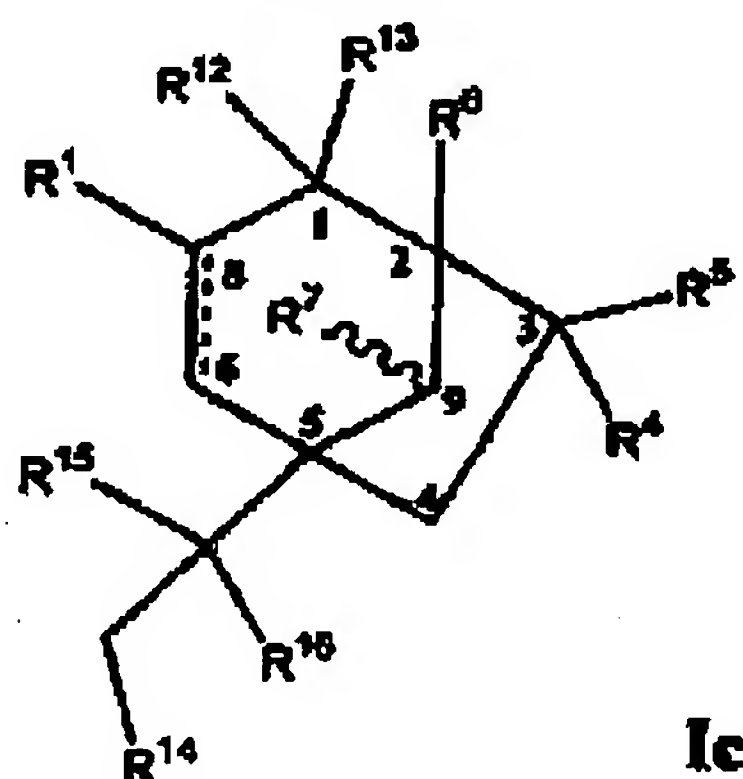
On page 4 of the Office Action, the Patent Office alleges that Cruciani et al. discloses each and every features of claims 1, 4-6, 15 and 16 and, in the alternative, alleges that if Applicant's specifically disclosed compounds are not directly disclosed, they would have been obvious since they fall within the generic broad disclosure of ketone compounds taught by Cruciani et al. Moreover, the Patent Office alleges Applicant's claims are deemed to be obvious over the generic disclosure of the document's method of making the ketone compounds.

Nowhere does Cruciani et al. teach or suggest a compound of formula I

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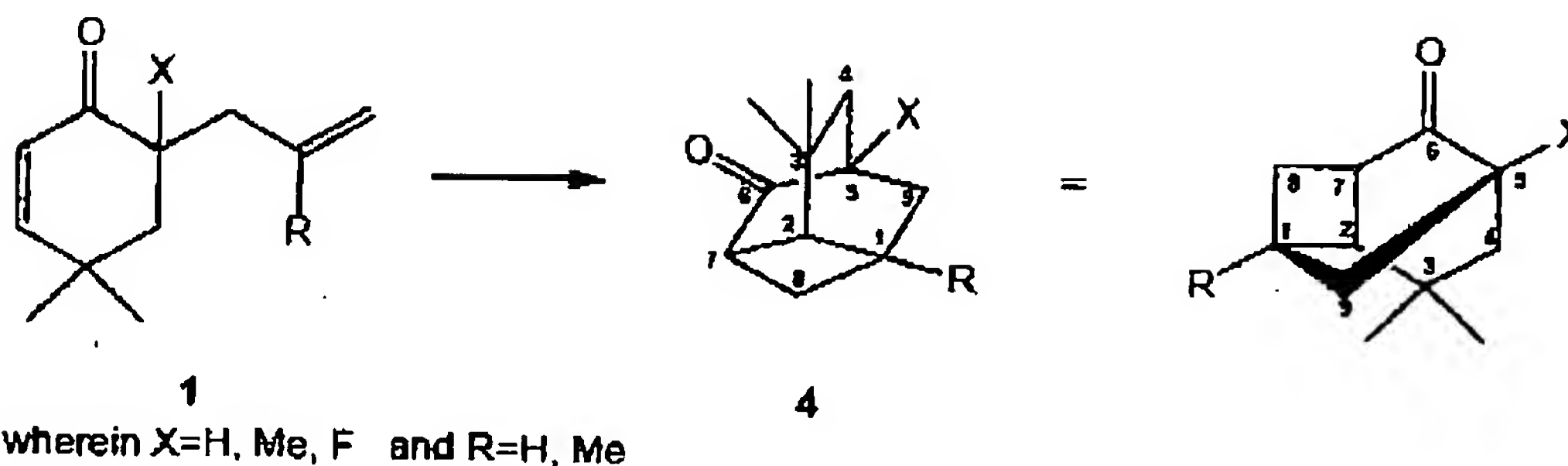
as required by claims 1 and 15. Additionally, Cruciani et al. fails to teach or suggest a process of preparing a compound of the general formula Ic



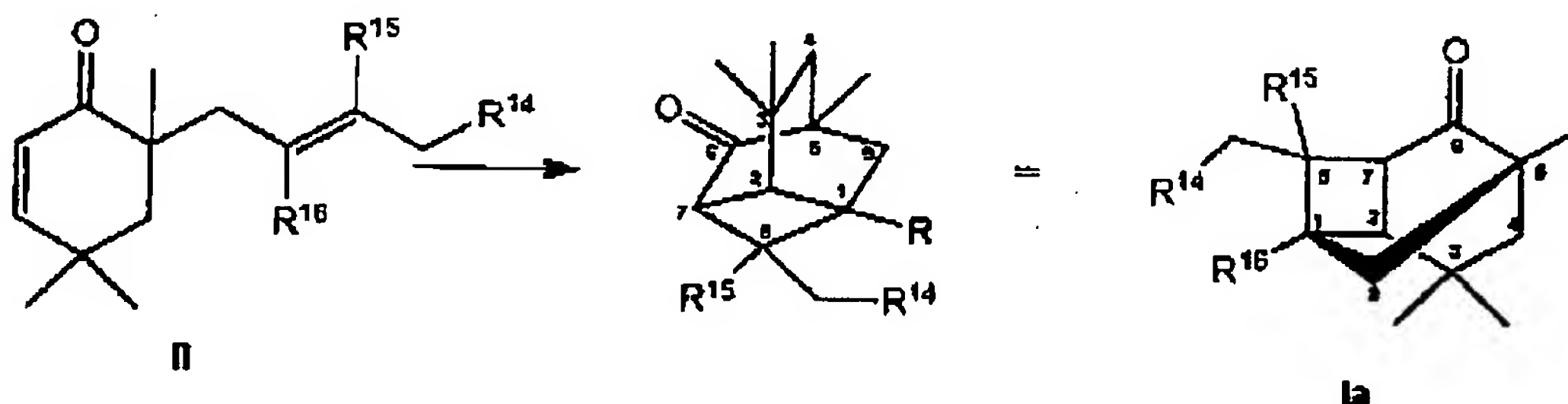
as required in claim 16.

Instead, Cruciani et al. relates to the effect of substituent on the photoisomerization of 6-allylcyclohex-2-enones 1 in MeCN, giving tricycle[3.3.1.0^{2,7}]nonan-6-ones 4 as shown below:

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On the other hand, claims 1, 15 and 16 require compounds that are at least mono-substituted at C-8 (IUPAC numeration) starting from compound II, i.e., both starting material and the end-product are different as shown below (also see Scheme I in the present application):



By comparing the formula for the compounds of claims 1, 15 and 16 with the formula of the compound disclosed in Cruciani et al., it is clear that the presently claimed compounds do not fall within the generic compounds taught by Cruciani et al. Additionally, Cruciani et al. also fails to disclose that the compounds set forth therein could be used as flavor or fragrance ingredients. Moreover, no teaching of Cruciani et al. would encourage a person skilled in the art to modify compound 4 of Cruciani et al. at C-8, or to further substitute the allyl group of starting material compound 1. Only after further substitution of the allyl group would one get a compound of formula Ia (i.e., compounds of formula I wherein C5 and C8 and C9 and C6 (= C2 and C7, and C9 and C1 (IUPAC numeration are connected by a single bond, and n=1).

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Because these features of independent claims 1, 15 and 16 are not taught or suggested by Cruciani et al., this reference would not have rendered the features of claim 1, 4-6, 15 and 16 obvious to one of ordinary skill in the art.

In view of the foregoing, reconsideration and withdrawal of this rejection are respectfully requested.

Regarding the rejection of claims 12-14 under 35 USC 103(a) as allegedly being unpatentable over Cruciani et al.:

The Applicant respectfully traverses the rejection of the foregoing claims in view of Cruciani et al.

On page 4 of the Office Action, the Patent Office acknowledges that Cruciani et al. differ from Applicant's claimed invention in that there is not a direct disclosure to the use of the compounds to make flavor or fragrance compositions as set forth in claim 12-14. The Patent Office alleges that it would have been obvious to one having ordinary skill in the art to use the disclosed ketones in flavor or fragrance compositions since such is deemed to be at once envisaged since these types of ketones are well known in the art to be highly aromatic, and ketones in general are well known fragrances.

Claims 12-14 directly or indirectly depend from claim 1. As set forth above with respect to the rejection of claim 1 under 35 USC 102 as allegedly being anticipated by Cruciani et al., nowhere does Cruciani et al. teach or suggest a compound I as required in claim 1.

Because this feature of independent claim 1 is not taught or suggested by Cruciani et al., this reference would not have rendered the features of claims 12-14 obvious to one of ordinary skill in the art.

In view of the foregoing, reconsideration and withdrawal of this rejection are respectfully requested.

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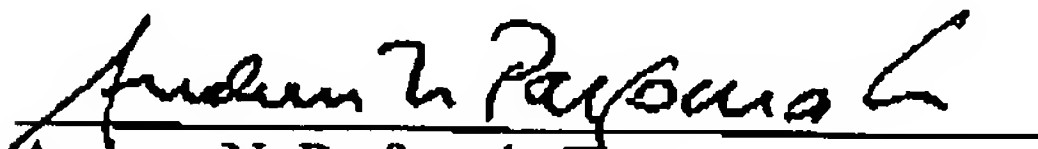
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Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience. The early issuance of a *Notice of Allowability* is solicited.

CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;



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Date:

CERTIFICATE OF TELEFAX TRANSMISSION UNDER 37 CFR 1.8

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Andrew N. Parfomak



Date

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